UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,343	11/26/2003	Lester F. Ludwig	A8679	9965

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EXAMINER
DINH, DUNG C

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/721,343	LUDWIG ET AL.
	Examiner	Art Unit	
	Dung Dinh	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 November 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-23 and 26-37* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-23 and 26-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 11/15/2005 have been fully considered.

The obviousness double patenting over patent 6,351,762 is withdrawn.

The argument is not persuasive with respect to the provisional obviousness double patenting. Applicant provided a summary comparing the amended claims on page 10 of the remark. As evidence by applicant summary of the claims, at least claim 1's of the '385/'905, '345 (10/721,343), and '051 applications are still substantially identical. The only different the '385/'905 and '051 is the phrase "no matter where the user is located". This feature is inherent from the use of the service record in claim 1 of the '385/'905 applications.

Regarding claim 1 of the '345 (10/721,343) application, the claim was amended to recite a quick dial list created from a list of all users. This language is not present in claims 1 of the '385/'905 and '051. However, the 'quick dial' list is equivalent to the 'personalized list' recited in the '385/'905 and '051 applications. Populating a personalized list using data from a master list clearly would have been obvious to one

of ordinary skill in the art. Hence, claim 1 of '345 is not

patentably distinct from claims 1 of '385/'905 and '051.

The provisional obviousness double patenting is maintained.

Regarding the rejection under 103, the argument is moot

view of new ground of rejection below.

Claims 1-4, 6-23, 26-37 are pending for examination.

Copy of non-patent references cited in this action is

provided in co-pending application 10/722,051.

Claim Rejections - Obviousness Double Patenting

The nonstatutory double patenting rejection is based on a
judicially created doctrine grounded in public policy (a policy
reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by
a patent and to prevent possible harassment by multiple
assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010
(Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.
Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and,
In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37
CFR 1.321(c) may be used to overcome an actual or provisional
rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be
commonly owned with this application. See 37 CFR 1.130(b).
Effective January 1, 1994, a registered attorney or agent
of record may sign a terminal disclaimer. A terminal disclaimer
signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-37 are provisionally rejected under the judicially

created doctrine of obviousness-type double patenting as being

unpatentable over claims 1-36 of Application No. 10/722,051,

claims 1-42 of Application 10/721,905, claims 1-42 of

Application 10/721,385. Although the conflicting claims are not

identical, they are not patentably distinct from each other

because they recite substantially equivalent limitations or

obvious variation thereof. This is a provisional rejection

because the claims are not in fact patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which
forms the basis for all obviousness rejections set forth in this
Office action:

> (a) A patent may not be obtained though the invention is
> not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject
> matter pertains. Patentability shall not be negatived by
> the manner in which the invention was made.

Claims 1-4, 6-23, 26-37 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Michael Banks "America Online: A

Graphics Based Success Evaluation", and further in view of

Baumgartner et al. US patent 5,195,086, and Marshak "Beyond Mail

for Windows" and Kamerman et al. **US patent 5,519,834, Vin et al.**
"Multimedia Conferencing in the Etherphone Environment".

As per claim 1, Banks discloses a method of real-time
communication essentially as claimed, comprising:

providing collaboration initiation software (p.~73~ AOL
programs);

allowing a plurality of users to connect to respective
communication networks by logging in (dial-in through their
modem);

in response to user logging in, maintaining service records
for the logged in users (inherent from top of page 3 in order to
track which users are currently online); the service records
including user identification (screen name) and location
information [inherent that AOL system must kept some type of
location information such as address, port number, and/or other
indicia in order for AOL system to transmit data to the user
terminal);

using retrieved addressing information to cause the
establishing of a connection between the users (apparent in
order to establishing real-time conference and "instant-message"
between users. See bottom of page 2 to top of page 3);

Banks does not specifically disclose displaying user
identifiers with graphical icons for selection by the first user
to establish a communication. In similar field of real time
conferencing, Baumgartner teaches a conferencing system with
directory displaying a list of available participants using
icons for easy selection [see fig.18, col.15 lines 46-45, col.18
lines 57-60]. AOL advantage of over other system at the time
was the use of graphics (see page 1). Baumgartner discloses that
graphical user interface is "an important idea for the
conference room notion" (col.15 liens 42-45). Hence, it would
have been obvious for one of ordinary skill in the art to
combine the teaching of Baumgartner with AOL system to display
user name along with graphical icons because it would have
enabled the user to visually associate member with the icon and
provided graphical means of selecting the participants for
conferencing.

Baumgartner does not specifically disclose a selecting user
identifier from a personalized list. Marshak discloses that it
is known in the computer collaborative art to provide global and
private directories to look up users of the system (address
books - see page 4 "Managing address book"). It would have been
obvious for one of ordinary skill in the art to provide a
personalized list because it would have enable the user to more

efficiently group and identify participants he wished to
collaborate with instead of browsing through a long master list
containing all users of the system.

As per claim 2, AOL system is capable of text messaging
("instant-messaging").

As per claim 3, Banks and Baumgartner do not specifically
disclose a wireless device. Computer with wireless network
access is well known in the art at the time of the invention
(for example see Kameraman col.1). Wireless network connection
reduces physical wiring and permits the computer to roam about.
Hence, it would have been obvious for one of ordinary skill in
the art to have a communication device being wireless device
because it would have enabled the user to be mobile while
participating in a conference.

As per claim 4, Users geographically remote from each other
may logged on and participate in real-time conference. Hence
AOL constitutes a wide area network as claimed. Furthermore
Baumgartner teaches the communication network is a wide area
network (fig.14, 15).

As per claim 6, Baumgartner teaches the usage of graphical
icon representing users [fig.18,].

As per claim 7, it is apparent from Banks (top of page 3) that a check to see whether a member is online would return a status of 'not logged in' if the member is not online.

As per claim 8, Baumgartner discloses adding new user to an existing communication (col.17 lines 22+, merging and splitting calls).

As per claims 9-10, Baumgartner teaches the permitting a user to participating in multiple conferences at the same time (col.2 lines 6-15, col.18 lines 14-20). Baumgartner does not specifically disclose notifying of attempt to communicate by a third user. In similar field of computer conferencing, Vin teaches to automatic notifying user of attempt to communicate [page 77 col.2 ringing] and permit a user to participate in multiple conferences [page 78 col.3]. It have been obvious for one of ordinary skill in the art to provide notification to alert user of attempt to communicate with him so as alert the user to pending call while still participating in another conversation.

As per claim 11, Banks and Baumgartner teach allowing user to send email [Banks page 2 last paragraph 'e-mail' and Baumgartner col.14 lines 22].

As per claims 12 and 13, Baumgartner teaches the conference including sending picture/video image of participant (col.14 lines 30-341).

As per claims 14-23, 25-27 they are rejected under similar rationale as claims 1-4, 6-13 above. Baumgartner teaches the permitting a user to participating in multiple conferences at the same time (col.2 lines 6-15, col.18 lines 14-20). Baumgartner does not specifically disclose notifying of attempt to communicate to user. Official notice is taken that it is well known in the communication art to provide notification and identification of a caller (e.g. a phone ring and caller ID) so that the recipient can see who is calling and decide to take the call or not. Furthermore, in similar field of computer conferencing, Vin teaches to automatic notifying user of attempt to communicate [page 77 col.2 ringing] and permit a user to participate in multiple conferences [page 78 col.3]. It have been obvious for one of ordinary skill in the art to provide notification including identification of the caller because it would have enable the system to alert the user of incoming call and the identification would enable the user screen the call.

As per claims 29-33 and 36, they are rejected under similar rationale as claims 1-4, 6-13 above. Banks and Baumgartner do not

specifically disclose a wireless device. Computer with wireless

network access is well known in the art at the time of the

invention (for example see Kameraman col.1). Wireless network

connection reduces physical wiring and permits the computer to

roam about. Hence, it would have been obvious for one of

ordinary skill in the art to have a communication device being

wireless device because it would have enabled the user to be

mobile while participating in a conference.

As per claims 35 and 37, Banks and Baumgartner do not

specifically disclose displaying indication and identity of the

caller. Official notice is taken that it is well known in the

communication art to provide automatic notification and

identification of a caller (e.g. a phone ring and caller ID) so

that the recipient can see who is calling and decide to take the

call or not. Furthermore, in similar field of computer

conferencing, Vin teaches to automatic notifying user of attempt

to communicate [page 77 col.2 ringing] and permit a user to

participate in multiple conferences [page 78 col.3]. It have

been obvious for one of ordinary skill in the art to provide

notification including identification of the caller because it

would have enable the system to alert the user of incoming call

and the identification would enable the user screen the call.

Prior Art Cited

The following references are cited but not used are deem

relevant to the claimed invention:

"BeyondMail for Intelligent Messaging/Windows - Quick

Reference" discloses using a master address book (Street Talk)

to create personal private address book (see page 2).

IBM TDB "Automatic Query of the Recipient ID upon Sending a

Distribution" discloses displaying list of user ID who are

currently online to enable a user to make a selection.

JP 2002441 discloses displaying a menu including name and

terminal location of user to select so as to make a call.

JP 1318136 discloses record of user logon and logoff

status.

Conclusion

Any inquiry concerning this communication or earlier
communications from the examiner should be directed to Dung Dinh
whose telephone number is (571) 272-3943. The examiner can
normally be reached on Monday-Friday from 7:00 AM - 3:00 PM.
If attempts to reach the examiner by telephone are
unsuccessful, the examiner's supervisor, Glenton Burgess can be
reached at (571) 272-3949.
The fax phone number for the organization where this
application or proceeding is assigned is 571-273-8300.
Information regarding the status of an application may be
obtained from the Patent Application Information Retrieval
(PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status
information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system,
see http://pair-direct.uspto.gov. Should you have questions on
access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Dung Dinh
Primary Examiner
January 21, 2006